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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,087	08/28/2001	Casey C. Case	8325-0002.21	7166

7590 12/02/2003

Sean M. Brennan
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EXAMINER

BRUSCA, JOHN S

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/942,087	CASE ET AL.	
	Examiner	Art Unit	
	John S. Brusca	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8-12 and 14 is/are rejected.
- 7) ☒ Claim(s) 2-7,13,15-23 and 25-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3/03/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is a non-final Office action in view of the new grounds of rejection under double patenting.

Information Disclosure Statement

2. The Form 1449 attached to the Information Disclosure Statement filed 03 March 2003 has been completed and all references except reference C-36 and C-153 have been indicated as considered. Reference C-153 is not an appropriate prior art reference for inclusion in an Information Disclosure Statement because it is not a prior art reference available to the public. Reference C-36 was not entered into the application file, and it appears to be an incorrect citation that was not retrievable from the USPTO library for consideration.

Oath/Declaration

3. The Rule 63 Declaration filed 24 January 2002 has been accepted in view of the Application Data Sheet filed 29 September 2003 which establishes the signature above the name of Alan Wolffe as the legal representative of the deceased inventor.

Claim Rejections - 35 USC § 112

4. The rejection of claims 1-24, and 31-34 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods of delivery of zinc finger proteins to cells by introduction of an expression vector, does not reasonably provide enablement for methods of delivery of zinc finger proteins to cells by introduction of exogenous zinc finger proteins to cells in the Office action mailed 12 August 2003 is withdrawn in view of the amendment filed 29 September 2003.

Terminal Disclaimer

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5. The terminal disclaimer filed on 29 September 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Numbers 6,534,261, 6,607,882, and copending Application numbers 09/706243, 09/897844, and 10/222614 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

6. The rejection of claims 1-8, 10-14, and 25-34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 18-22, 25-28, 30-41, 47, 49-51, 54-57, 59-70, 74-78, and 81-84 of U.S. Patent No. 6,534, 261 in the Office action mailed 12 August 2003 is withdrawn in view of the terminal disclaimer filed 29 September 2003.

7. The provisional rejection of claims 1-8, 10, 11, 14, and 25-34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 31, 34-43, 50-54, and 57-60 and 62 of copending Application No. 09/478681, now U.S. Patent No. 6,607,882, in the Office action mailed 12 August 2003 is withdrawn in view of the terminal disclaimer filed 29 September 2003.

8. The provisional rejection of claims 1-8, 10-12, 14, and 24-34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 18-23, 26-29, 31-42, 48-53, 56-59, 61-72, 76-81, and 84-87 of copending Application No. 09/897844 in the Office action mailed 12 August 2003 is withdrawn in view of the terminal disclaimer filed 29 September 2003.

9. The provisional rejection of claims 1, 2-8, 10-12, 14, 24, 31, 32, and 34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

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claims 118-129, 136-139, 141-152, 159-161, 163-170, 172-174, 179-183 of copending

Application No. 09/706243 in the Office action mailed 12 August 2003 is withdrawn in view of the terminal disclaimer filed 29 September 2003.

10. The provisional rejection of claims 1, 12, and 14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 89, 90, and 92 of copending Application No. 10/222614 in the Office action mailed 12 August 2003 is withdrawn in view of the terminal disclaimer filed 29 September 2003.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would be obvious over, the reference claim(s). see, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

12. Claims 1, 8-12, and 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-22 and 31-34 of copending Application No. 10/245415. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims are species of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would be obvious over, the reference claim(s). see, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Allowable Subject Matter

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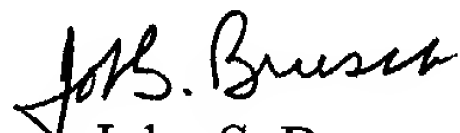
14. Claims 2-7, 13, 15-23, and 29-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 703 308-4231. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703 308-4028. The fax phone number for the organization where this application or proceeding is assigned is 703 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0196.


John S. Brusca
Primary Examiner
Art Unit 1631

jsb